

application, including any extension of time fees required for an Examiner's Amendment, to Deposit Account No. 19-0089.

## **REMARKS**

### **Summary of Office Action**

Claims 7, 11-13, 21, 22 and 24-37, i.e., all claims of record, are rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as claims 1, 16, 3-15 and 22-27 of prior U.S. Patent No. 6,689,228 B2 to KÖCK et al. (hereafter "KÖCK").

### **Response to Office Action**

Withdrawal of the rejections of record is respectfully requested, in view of the following remarks.

The Office Action indicates that Applicants' arguments filed on October 18, 2004 as to why the rejection of the present claims over KÖCK is not justified have not been found persuasive. The Office Action does not discuss these arguments with any specificity, and essentially merely asserts that KÖCK and the present application allegedly show that the terms "rolling stock" and "rail" and the terms "liquid cooling devices" and "submersion basins" are used interchangeably in these two documents. In this respect, the rejection refers to col. 2, lines 62-67 wherein rolling stock is allegedly defined as rails, and to claim 2 of KÖCK where

“rails” is used in place of “rolling stock”. Further, the rejection contends that at page 5, first paragraph of the present specification “liquid cooling devices” are defined as “submersion basins”.

Applicants respectfully traverse this rejection. With respect to the allegation that KÖCK defines “rolling stock” as “rail”, Applicants submit that col. 2, lines 62-67 of KÖCK specifically relied on in the rejection make it particularly clear that “rolling stock” encompasses more than merely rails. This passage refers to one aspect or embodiment of the device in which “the rolling stock is a rail, e.g., a rail having a length greater than 50 m.”

First, it would appear to not make any sense (and to even create confusion) to use two different terms for the same thing. This is particularly true when these two different terms for the same thing are used in the same sentence. In fact, if one were to assume, *arguendo*, that in KÖCK the terms “rolling stock” and “rail” are interchangeable, the first sentence in the passage pointed out in the present Office Action would read: “In one aspect of the device, the rail is a rail, ...”. It becomes immediately clear that there is something wrong with this sentence.

Further, according to claim 22 of KÖCK, the “rolling stock” recited in independent claim 21 is a rail. Claim 22 would be superfluous and would not have been allowed if “rolling stock” and “rail” were merely different terms for the same thing.

In any event, “rolling stock” doubtlessly is a generic term that encompasses, *inter alia*, rails. On the other hand, “rail” is not a generic term that

encompasses, *inter alia*, rolling stock. Clearly, these terms are related as genus and species.

Applicants additionally point out that the Examiner has not provided any documentary evidence whatsoever to support the assertion that the terms “rolling stock” and “rail” denote the same thing and can be used interchangeably.

Applicants note that the Examiner has pointed to claim 2 of KÖCK wherein “said rail” is referred to although claim 1 from which claim 2 depends does not recite any rail at all, but rather recites “rolling stock” several times. It is submitted that there is indeed a discrepancy between these two claims because there clearly is no antecedent basis in claim 1 (and claim 2) for the phrase “said rail”. Accordingly, it is apparent that there is an error in claim 2 of KÖCK in that the phrase “said rail” should correctly have read “said rolling stock”, i.e., the term invariably used in claim 1. Applicants are in the process of filing a request for a Certificate of Correction in the Patent and Trademark Office to have this error in claim 2 of KÖCK corrected.

Turning now to the terms “liquid cooling devices” and “submersion basins”, Applicants respectfully submit that the Examiner’s corresponding contention is without merit as well. In particular, the passage of the present application which is relied on in the present Office Action in this context, i.e., page 5, first paragraph, states:

If, as may be provided in one embodiment of the invention, the liquid cooling devices are formed as submersion basins that have horizontally and vertically oriented stops acting on the bottom and,

optionally, laterally for leveling and aligning the rolling stock, it is possible, in particular in the case of the cooling of parts of the cross section of a rail, for a highly consistent cooling and distribution of the hardness to be achieved over its length, which helps to ensure the quality of the product.

The above passage (which is substantially identical with column 4, lines 24-33 of KÖCK) makes it clear that the term “liquid cooling devices” is a generic term and includes, *inter alia*, submersion basins. Specifically, according to this passage, if (a) submersion basins are used as liquid cooling devices and (b) these submersion basins have horizontally and vertically oriented stops acting on the bottom and, optionally, laterally for leveling and aligning the rolling stock, it is possible to obtain a highly consistent cooling and distribution of hardness over the length of the rolling stock, in particular if parts of the cross section of a rail are cooled with such submersion basins.

It is not seen that anything in this passage indicates or conveys the impression that “liquid cooling devices” and “submersion basins” are the same. On the contrary, it is taught therein that the use of (specifically equipped) submersion basins as the “liquid cooling devices” of the claimed device may entail particular advantages in some instances, in particular, when the rolling stock is a rail and parts of the cross section thereof are cooled therewith (which confirms again that “rolling stock” encompasses, but is not the same as “rail”).

Applicants additionally note that the Examiner has failed to provide any written evidence to support the allegation that “liquid cooling devices” and “submersion basins” are the same (interchangeable).

To sum up, for at least the reasons already set forth in the Amendment filed October 18, 2004, which reasons are expressly incorporated herein, none of the claims of record are directed to subject matter that is identical to the subject matter of any of the claims of KÖCK relied on in the present rejection. The only reasons set forth in the present Office Action as to why Applicants’ corresponding arguments have not been found persuasive are without any merit, as shown above. Accordingly, withdrawal of the rejection of the present claims under 35 U.S.C. § 101 is warranted and respectfully requested.

## CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,  
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